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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/586,828

07/20/2006

Dirk Muhlhoff

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8981

24113

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08/25/2010

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EXAMINER

CRANDALL, LYNSEY P

ART UNIT

PAPER NUMBER

3769

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/586,828	<b>Applicant(s)</b> MUHLHOFF ET AL.	
	<b>Examiner</b> LYNSEY CRANDALL	<b>Art Unit</b> 3769	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 August 2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 23-47 is/are pending in the application.
- 4a) Of the above claim(s) 29-44 and 47 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 23-28, 45 and 46 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 June 2008 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>8/20/2008</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Election/Restrictions*

1. Applicant's election without traverse of group 1 (claims 23-28, 45 and 46) in the reply filed on 8/16/2010 is acknowledged.
2. Claims 29-44 and 47 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 8/16/2010.

### *Drawings*

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the holding element and stop of claim 26 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering

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of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

4.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 26 and 27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. Claim 26 recites the limitation "the housing" in line 2. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section

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351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 23-28 are rejected under 35 U.S.C. 102(b) as being anticipated by US 5,336,215 to Hsueh et al.

10. [Claims 23-24 and 28] Hsueh discloses a laser treatment apparatus for ophthalmic surgery, comprising: a headrest for a patient (18, Fig. 1); a contact glass (54, Fig. 2), which can be placed onto an eye (56, Fig. 2) of the patient and through which a treatment beam is incident (24, Fig. 2); and a safety mechanism (compensating device 36, Fig. 2) which moves the headrest and the contact glass apart when a force is directed onto the contact glass substantially counter to the direction of incidence; wherein the safety mechanism enables separating movement only at a force exceeding a limit value of force and substantially fixes the headrest and the contact glass relative to each other if the force is below the limit value of force. Hsueh discloses setting a desired limit value of force (opposing force), specifically in the range from 0-300 grams (0 to 2.94 Newtons). This desired value of force is chosen by the user according to the particular needs of the operator (Col 4, lines 31-55). Once this value is set, the compensating device maintains this force between the contact glass and the eye to be substantially constant. Any subsequent movement of the eye will be opposed by the substantially constant force of the compensating device and will cause movement of only the frame (30, Fig. 2) and the components which are fixedly attached thereto (Col 6, lines 13-29). This is interpreted as a separating movement or retraction of the

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contact glass that occurs only at a force exceeding the predetermined limit value chose by the operator.

11. [Claim 25] Hsueh discloses that the limit value of force is caused by the weight force of the contact glass (Col 3, lines 16-19).

12. [Claim 26] Hsueh discloses that the contact glass (54, Fig. 2) is mounted to a holding element (frame 30, Fig. 2) which is pressed against a stop of the housing (base 28, Fig. 2) with a force defining the limit value of force (Col 4, lines 32-55).

13. [Claim 27] The holding element (frame 30, Fig. 2) includes focusing optics (lens 40, Fig. 2) to focus the treatment laser beam into or onto the eye.

14. Claims 23, 45 and 46 are rejected under 35 U.S.C. 102(e) as being anticipated by US 2005/0192562 to Loesel et al.

15. [Claim 23] Loesel discloses a laser treatment apparatus for ophthalmic surgery, comprising: a headrest (platform 14, Fig. 1); a contact glass (eye stabilizing element 20 which is placed on the eye; Fig. 1); and a safety mechanism (controller 26, Fig. 1) which moves the headrest and the contact glass apart when a force is directed onto the contact glass substantially counter to the direction of incidence; wherein the safety mechanism enables separating movement only at a force exceeding a limit value of force and substantially fixes the headrest and the contact glass relative to each other if the force is below the limit value of force. Loesel teaches that "during the docking procedure, the interactive forces that are generated between the eye stabilizing element and the alignment device are monitored by the pressure sensors. It can be appreciated by those skilled in the art that the force magnitudes experienced by the pressure

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sensors, and the differentials between the force magnitudes, can be used to determine the magnitude and direction of the forces exerted against the eye 18 during the docking procedure. In this way, the operation of the system is monitored to ensure patient safety, and to minimize the risk of unwanted damage to the eye. Specifically, whenever a predetermined force threshold is reached, either in the direction or the magnitude of the forces exerted on the eye, further movement of the patient toward the surgical laser unit is prevented by the computer controller. Stated differently, when the threshold force values are reached, the chair and the patient can only be moved in a direction away from the surgical laser unit" (Par 0038). This is considered a separating movement that occurs only at a force exceeding the predetermined limit value; Otherwise the headrest and contact glass remain fixed relative to each other if the force is below the limit value of force.

16. [Claims 45 and 46] Loesel teaches that the headrest (platform 14, Fig. 1) is a chair that includes a drive (motorized control assembly 24, Fig. 1) which can be selectively activated to move and reconfigure the chair. Further, the safety mechanism (computer controller 26, Fig. 1) is in electronic communication with the motorized control assembly of the chair for directing the movement of the chair.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LYNSEY CRANDALL whose telephone number is (571)270-7035. The examiner can normally be reached on Monday to Thursday 8:00-5:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hank Johnson can be reached on (571)272-4768. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/LYNSEY CRANDALL/  
Examiner, Art Unit 3769

/Henry M. Johnson, III/  
Supervisory Patent Examiner, Art  
Unit 3769

8/24/2010